

ESTTA Tracking number: **ESTTA643491**

Filing date: **12/09/2014**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91219124
Party	Defendant American Steamboat Company, LLC
Correspondence Address	ROBERT P HERRE PO BOX 384 GOSHEN, KY 40026-0384 UNITED STATES rpherre@aol.com
Submission	Answer
Filer's Name	Robert P. Herre
Filer's e-mail	rpherre@aol.com
Signature	/Robert P. Herre/
Date	12/09/2014
Attachments	Answer to Notice of Opposition 12-9-14.pdf(224880 bytes)

In Re Trademark Application Serial Nos.: 86/297,459 and 86/277,094

Published: 10/7/2014

Applicant.

Opposition No. 91219124

APPLICANT’S ANSWER TO NOTICE OF OPPOSITION
AND AFFIRMATIVE DEFENSES

FIRST DEFENSE

- 1

Applicant lacks sufficient information to form a belief as to the truth of the remaining allegations set forth in paragraph 2, and therefore denies same.

3. Applicant lacks sufficient information to form a belief as to the truth of the allegations set forth in paragraph 3, and therefore denies same.

4. Applicant admits the allegations of paragraph 4 to the extent that the documents referenced therein were attached to the Notice of Opposition. Applicant lacks sufficient information to form a belief as to the truth of the remaining allegations set forth in paragraph 4, and therefore denies same.

5. Applicant denies the allegations of paragraph 5 to the extent that Opposer claims to have exclusive rights to the term “American” as alleged in the Notice of Opposition. Applicant lacks sufficient information to form a belief as to the truth of the remaining allegations set forth in paragraph 5, and therefore denies same.

6. Applicant denies the allegations of paragraph 6 to the extent that Opposer claims to have exclusive rights to the term “American” as alleged in the Notice of Opposition. Applicant lacks sufficient information to form a belief as to the truth of the remaining allegations set forth in paragraph 6, and therefore denies same.

7. Applicant denies the allegations of paragraph 7 to the extent that Opposer claims to have exclusive rights to the term “American” as alleged in the Notice of Opposition. Applicant lacks sufficient information to form a belief as to the truth of the remaining allegations set forth in paragraph 7, and therefore denies same.

8. Applicant denies the allegations of paragraph 8 to the extent that Opposer claims to have exclusive rights to the term “American” as alleged in the Notice of Opposition. Applicant lacks sufficient information to form a belief as to the truth of the remaining allegations set forth in paragraph 8, and therefore denies same.

9. Applicant admits the allegations of paragraph 9 insofar as Applicant does not contravene matters of public record. Applicant lacks sufficient information to form a belief as to the truth of the remaining allegations set forth in paragraph 9, and therefore denies same.

10. Applicant denies the allegations of paragraph 10 to the extent Opposer claims to have exclusive rights to the term “American” as alleged in the Notice of Opposition. Applicant lacks sufficient information to form a belief as to the truth of the remaining allegations set forth in paragraph 10, and therefore denies same.

11. Applicant admits the allegations of paragraph 11 insofar as Applicant does not contravene matters of public record. Applicant lacks sufficient information to form a belief as to the truth of the remaining allegations set forth in paragraph 11, and therefore denies same.

12. Applicant denies the allegations of paragraph 12.

13. Applicant states that paragraph 13 is a legal conclusion to which no response is required. To the extent a response is required, Applicant denies the allegations of paragraph 13.

14. Applicant denies the allegations of paragraph 14 to the extent Opposer claims to have exclusive rights to the term “American” as alleged in the Notice of Opposition and to the extent Opposer alleges that consumers have come to recognize the term “American” as signifying Opposer in any fashion. Applicant lacks sufficient information to form a belief as to the truth of the remaining allegations set forth in paragraph 14, and therefore denies same.

15. Applicant denies the allegations of paragraph 15.

16. Applicant admits the allegations of paragraph 16 to the extent that it has not used the full, exact phrase and mark AMERICAN COUNTESS but denies the remaining allegations of paragraph 16.

17. Applicant admits the allegations of paragraph 17 to the extent that it has not used the full, exact phrase and mark AMERICAN PRINCESS but denies the remaining allegations of

paragraph 17.

18. Applicant denies the allegations of paragraph 18 to the extent Opposer claims to have exclusive rights to the term “American” as alleged in the Notice of Opposition. Applicant admits the remaining allegations set forth in paragraph 18.

19. Applicant states that paragraph 19 is a legal conclusion to which no response is required. To the extent a response is required, Applicant denies the allegations of paragraph 19.

20. Applicant denies the allegations of paragraph 20 to the extent Opposer claims to have exclusive rights to the term “American” as alleged in the Notice of Opposition. Applicant admits the remaining allegations set forth in paragraph 20.

21. Applicant denies the allegations of paragraph 21 to the extent Opposer claims to have exclusive rights to the term “American” as alleged in the Notice of Opposition. Applicant admits the remaining allegations set forth in paragraph 21.

22. Applicant states that paragraph 22 is a legal conclusion to which no response is required. To the extent a response is required, Applicant denies the allegations of paragraph 22.

23. Applicant states that paragraph 23 is a legal conclusion to which no response is required. To the extent a response is required, Applicant denies the allegations of paragraph 23.

24. Applicant states that paragraph 24 is a legal conclusion to which no response is required. To the extent a response is required, Applicant denies the allegations of paragraph 24.

25. Applicant denies that Opposer is entitled to the relief requested in its Notice of Opposition.

SECOND DEFENSE

Applicant states that this proceeding involves identical issues of law and fact as exist in litigation pending between Opposer and related entities of Applicant in a case styled *American Cruise Lines, Inc. v. HMS American Queen Steamboat Company, LLC and American Queen*

Steamboat Operating Company, LLC, Case No. 13-CV-00324, U.S. District Court for the District of Delaware (“the Pending Litigation”). Therefore, this proceeding should be suspended pending disposition of the Pending Litigation pursuant to Trademark Rule 2.117(a) (37 C.F.R. §2.117(a)) and §510.02(a) of the Trademark Board Manual of Procedure (“TBMP”).

THIRD DEFENSE

Applicant states that the Notice of Opposition fails to state a claim for which relief may be granted.

FOURTH DEFENSE

Opposer will suffer no damage upon the registration of Applicant’s mark and, therefore, lacks standing to bring this Notice of Opposition.

FIFTH DEFENSE

Applicant relies upon all defenses available under the Lanham Act, 15 U.S.C. §1051, *et seq.* as a complete or partial defense to the claims asserted by Opposer.

SIXTH DEFENSE

Applicant’s AMERICAN COUNTESS and AMERICAN PRINCESS marks are not likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection, or association of Applicant with Opposer, or as to the origin, sponsorship, or approval of Opposer’s services.

SEVENTH DEFENSE

Applicant states that Opposer does not own exclusive trademark or service mark rights in and to the term “American” as alleged in the Notice of Opposition.

EIGHTH DEFENSE

Applicant claims priority in and to the term “American” as used in connection with the parties’ respective goods and/or services.

NINTH DEFENSE

Applicant reserves the right to assert additional defenses in the event discovery reveals the existence of such defenses.

AFFIRMATIVE DEFENSES

Applicant asserts the affirmative defenses of unclean hands, laches, estoppel and/or acquiescence, and further reserves the right to assert any and all other affirmative defenses or counterclaims as may be revealed during the course of discovery.

Wherefore, the Applicant prays that the Notice of Opposition be dismissed.

Dated: December 9, 2014

Respectfully submitted,

/Robert P. Herre/

Robert P. Herre
PO Box 384
Goshen, KY 40026

COUNSEL FOR APPLICANT
AMERICAN STEAMBOAT
COMPANY, LLC

CERTIFICATE OF SERVICE AND ELECTRONIC SUBMISSION

The undersigned hereby certifies that a true and correct copy of this Answer has been submitted via ESTTA and served via electronic mail, on December 9, 2014, on the following counsel of record for Opposer:

Mark B. Harrison
VENABLE LLP
575 7th St. NW
PO Box 34385
Washington, D.C. 20004-1607
mbharrison@Venable.com

/Brian McGraw/

COUNSEL FOR OPPOSER